

REMARKS

Applicant submits this Amendment in reply to the Office Action mailed November 29, 2005.

As an initial matter, Applicant notes that two claims numbered 49 were inadvertently listed in the Preliminary Amendment filed February 5, 2002. The second claim 49 should have been numbered as claim 50. Applicants have corrected the error in this Amendment and apologize for any confusion it may have caused.

By this Amendment, Applicants have amended claims 18, 19, 25, 26, 27, 30, and 38, and added new claims 51-70. The originally-filed specification, drawings, and claims fully support the subject matter of amended claims 18, 19, 25, 26, 27, 30, and 38, and new claims 51-70. No new matter has been introduced.

Before entry of this Amendment, claims 18-50 were pending in this application. After entry of this Amendment, claims 18-70 are pending in this application. Claims 18, 30, 41, 47, 51, 55, 58, 61, 65, and 68 are the sole independent claims.

On pages 2-4 of the Office Action, claims 1-26 and 28-40 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,738,096 to Ben-Haim et al. ("Ben-Haim"), and claims 27 and 41-49 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ben-Haim in view of U.S. Patent No. 5,728,091 to Payne et al. ("Payne"). Applicants respectfully traverse these rejections.

Neither Ben-Haim nor Payne, either alone or in combination, discloses or suggests the claimed invention as set forth in any of independent claims 18, 30, and 47.

For example, independent claim 18 recites an apparatus for measuring a thickness of a heart wall including, among other aspects, "a device configured to form a passage in the heart wall based on the measurement corresponding to the thickness of the heart wall."

In another example, independent claim 30 recites a method for measuring a thickness of a heart wall including, among other aspects, "forming a passage in the heart wall based on the measurement corresponding to the thickness of the heart wall." In a further aspect, independent claim 47 recites a method for supplying blood to the heart including, among other aspects, "forming a recess in the heart wall based on the measured thickness." Neither Ben-Haim nor Payne discloses or suggests at least these aspects of the claims either alone or in combination with the other aspects of the respective claims.

Page 3 of the Office Action admits that Ben-Haim does not disclose "the step or structure of lasing or drilling to form a recess/channel in the heart wall." The Office Action then asserts, however, that Payne discloses "lasing or drilling to form a recess/channel in the heart wall." Even assuming *arguendo* that this is correct, neither Ben-Haim nor Payne discloses forming a passage or recess based on the measured thickness of the heart wall as set forth in each of independent claims 18, 30, and 47, and the Office Action on pages 3-4 does not address this claim aspect. Indeed, neither reference discloses any relationship between the passage or recess and the measured thickness of the heart wall. Accordingly, for at least these reasons, Applicants

respectfully request allowance of independent claims 18, 30, and 47, and their respective dependent claims.

Neither Ben-Haim nor Payne, either alone or in combination, discloses the inventions set forth in any of independent claims 41, 58, and 68. For example, independent claim 41 recites, among other aspects, "creating a passage in the heart wall via the instrument, the passage being disposed at an angle with respect to a perpendicular to the heart wall at a location on the heart wall corresponding to the position of the distal end of the instrument." Independent claims 58 and 68 recite similar aspects. Neither Ben-Haim nor Payne discloses or suggests at least these aspects of the claims either alone or in combination with the other aspects of the respective claims. Indeed, in rejecting claim 41, the Office Action does not set forth how either Ben-Haim or Payne discloses this aspect at all. Accordingly, for at least these reasons, Applicants respectfully request allowance of independent claims 41, 58, and 68, and their respective dependent claims.

Independent claims 51 and 61 include the subject matter of original dependent claims 19 and 35 rewritten into independent form. The subject matter of original dependent claims 19 and 35 were rejected solely over Ben-Haim. However, Ben-Haim does not disclose the inventions set forth in any of independent claims 51 and 61. For example, independent claim 51 recites, among other aspects, "wherein the member further includes a device that extends from the distal end of the member to penetrate the heart wall." Independent claim 61 recites similar aspects. Ben-Haim does not

disclose at least these aspects of the claims either alone or in combination with the other aspects of the respective claims.

Page 3 of the Office Action asserts that Ben-Haim discloses "a laser (col. 21, line 14) for penetrating the heart wall." However, the laser referred to in the aforementioned portion of Ben Haim is a Doppler laser perfusion meter which measures tissue blood flow such as "flow volume and/or the flow velocity." In such a Doppler laser perfusion meter, while laser energy from the meter may penetrate the heart wall, the laser-emitting meter, which Applicant assumes corresponds to the device of the claimed invention, does not penetrate the heart wall. Laser energy simply is not "a device." Accordingly, for at least these reasons, Applicant respectfully requests allowance of independent claims 51 and 61, and their respective dependent claims.

Independent claims 55 and 65 include subject matter either similar to original dependent claims 25 and 38 rewritten into independent form. Claims 25 and 38 were rejected solely over Ben-Haim. However, Ben-Haim does not disclose the inventions set forth in any of independent claims 55 and 65. For example, independent claim 55 recites, among other aspects, "wherein the indicator is inserted through a lumen defined by the member." Independent claim 65 recites similar aspects. Ben-Haim does not disclose at least these aspects of the claims either alone or in combination with the other aspects of the respective claims.

Page 2 of the Office Action asserts that Ben-Haim discloses "an ultrasound indicator/transducer (col. 20, lines 51-63) slidably disposed in a lumen proximate a

distal end of the catheter (72) in order to measure a thickness of the heart wall.”

Applicant respectfully disagrees. This portion of Ben-Haim discloses that ultrasonic sensors, including forward looking ultrasonic sensors and side looking ultrasonic sensors, are *mounted* on catheter 72. This implies that the ultrasonic sensors are fixed on catheter 72 and not necessarily inserted through a lumen defined by catheter 72. Accordingly, for at least these reasons, Applicant respectfully requests allowance of independent claims 55 and 65, and their respective dependent claims.

Applicant further submits that claims 19-29, 31-40, 42-46, 48-50, 52-54, 56, 57, 59, 60, 62-64, 66, 67, 69, and 70 depend either directly or indirectly from one of independent claims 18, 30, 41, 47, 51, 55, 58, 61, 65, and 68, and are therefore allowable for at least the same reasons that their respective independent claims are allowable. In addition, each of the dependent claims recite unique combinations that are neither taught nor suggested by the cited references and therefore each also are separately patentable.

In view of the foregoing remarks, Applicant requests the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

The Office Action contains characterizations of the claims and the related art with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any statement or characterization in the Office Action.

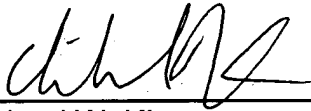
In discussing the specification, claims, and drawings in this Amendment, it is to be understood that Applicant is in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification and/or shown in the drawings. Rather, Applicant is entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Please grant any extensions of time required to enter this Amendment and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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